

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

Compression Labs, Incorporated,)
))
 Plaintiff,))
v.) C.A. No. 2:04-CV-158-DF
))
Agfa Corporation, et al.,))
 Defendants.))

**PLAINTIFF'S OPPOSITION TO ONKYO U.S.A. CORPORATION'S MOTION TO
DISMISS PURSUANT TO FED. R. CIV. P. 12(b)(7) OR, IN THE ALTERNATIVE,
TO TRANSFER PURSUANT TO 28 U.S.C. § 1404(a)**

I. INTRODUCTION

Defendant Onkyo U.S.A. Corporation's ("Onkyo") Motion to Dismiss or Transfer relies entirely upon the Motions to Dismiss or Transfer that were filed by the remaining defendants in this case on July 6, 2004, and incorporates by reference all of the arguments made in those motions. Accordingly, Plaintiff Compression Labs, Inc. ("CLI") asks that this motion be denied in its entirety for the reasons detailed in CLI's Opposition Brief¹ filed on July 26, 2004 and in CLI's Surreply Brief² filed on August 25, 2004, both of which are hereby incorporated by reference.

¹ *PLAINTIFF'S OPPOSITION TO DEFENDANTS' MOTION TO DISMISS UNDER FED. R. CIV. P. 12(B)(7), OR, IN THE ALTERNATIVE, MOTION TO TRANSFER* (Dkt. # 70) (hereafter referred to as "CLI's Opposition Brief")

² *PLAINTIFF'S SURREPLY BRIEF IN DEFENDANTS' MOTION TO DISMISS UNDER FED. R. CIV. P. 12(B)(7), OR, IN THE ALTERNATIVE, MOTION TO TRANSFER* (Dkt. # 98) (hereafter referred to as "CLI's Surreply Brief").

II. DISMISSAL UNDER RULE 12(B)(7) IS NOT PROPER

Onkyo argues that this case should be dismissed because General Instrument Corp. (“GI”) is not a party in this lawsuit. This argument fails for several reasons. First, CLI alone has the sole, exclusive, and unrestricted right and power to litigate, license, and defend the patent-in-suit³ in the JPEG field-of-use. GI is therefore not an indispensable party. Second, even if GI is a necessary and indispensable party, this case can only be dismissed if it is **not feasible** to join GI under Rule 19 of the Federal Rules of Civil Procedure. Joinder of GI under Rule 19 is **feasible** in this case. Therefore, at most, Rule 19 provides Onkyo with a remedy in the form of an order that GI be joined as a party. But, even this remedy is unwarranted because GI is not a necessary party, much less an indispensable one. CLI’s detailed analysis of these issues are provided in CLI’s Opposition Brief and Surreply Brief.

III. THIS COURT IS THE APPROPRIATE FORUM FOR THIS CASE

Onkyo’s motion to transfer this case to the District of Delaware pursuant to 28 U.S.C. § 1404 also fails because Onkyo has not carried its heavy burden of showing that the interest of justice and the convenience of the witnesses and parties will be better served by transferring this action. *See Z-Tel Communications, Inc. v. SBC Communications, Inc.*, --- F.Supp.2d ----, 2004 WL 1895110 at *3, 11 (E.D.Tex. Aug 06, 2004) (*citing and quoting Syndicate 420 at Lloyd’s London v. Early American Ins. Co.*, 796 F.2d 821, 828 (5th Cir.1986) (“the next step is to proceed to a balancing of the public and private interest factors, bearing always in mind that ‘unless the balance is strongly in favor of the defendant, the plaintiff’s choice of forum should rarely be disturbed.’”)); *see also Datamize, Inc. v. Fidelity Brokerage Services, LLC*, 2004 WL 1683171 at *12 (E.D.Tex.2004) (“the private and public interest factors of 28 U.S.C § 1404(a) weigh against transfer of this case”).

³ U.S. Patent No. 4,698,672, hereafter “the ‘672 Patent.”

CLI's detailed analysis of the factors considered for a transfer under § 1404(a) are detailed in CLI's Opposition Brief.

IV. CONCLUSION

For reasons set forth and detailed in CLI's Opposition Brief and Surreply Brief, CLI requests that this Court deny Onkyo's motion to dismiss and deny Onkyo's motion to transfer this case to the District of Delaware.

Respectfully submitted,
Compression Labs, Inc.

Dated: September 7, 2004

By: 

Stephen G. Rudisill (*attorney-in-charge*)

Illinois Bar No.: 2417049

Texas Bar No.: 17376050

srudisill@jenkens.com

John C. Gatz

Illinois Bar No.: 6237140

jgatz@jenkens.com

Russell J. Genet

Illinois Bar No.: 6255982

rgenet @jenkens.com

Justin D. Swindells

Illinois Bar No.: 6257291

jswindells@jenkens.com

JENKENS & GILCHRIST, P.C.

225 West Washington Street, Suite 2600

Chicago, Illinois 60606

Tel. (312) 425-3900

Fax (312) 425-3909

S. Calvin Capshaw III

Texas Bar No.: 03783900

ccapshaw@mailbmc.com

BROWN, McCARROLL, L.L.P.

1127 Judson Road, Suite 220

Longview, Texas 75601-5157

Tel. (903) 236-9800

Fax. (903) 236-8787

Franklin Jones, Jr.
Texas Bar No.: 00000055
maiezieh@millerfirm.com
JONES & JONES, Inc., P.C.
201 West Houston Street (75670)
P.O. Drawer 1249
Marshall, Texas 75670-1249
Tel. (903) 938-4395
Fax. (903) 938-3360

Otis Carroll
Texas Bar No.: 03895700
Jack Wesley Hill
Texas Bar No.: 24032294
nancy@icklaw.com
IRELAND, CARROLL & KELLEY, P.C.
6101 South Broadway, Suite 500
Tyler, Texas 75703
Tel. (903) 561-1600
Fax. (903) 581-1071

Carl R. Roth
Texas Bar No.: 17312000
cr@rothfirm.com
Michael C. Smith
Texas Bar No.: 18650410
ms@rothfirm.com
THE ROTH LAW FIRM
115 North Wellington, Suite 200
P.O. Box 876
Marshall, Texas 75670
Tel. (903) 935-1665
Fax (903) 935-1797

ATTORNEYS FOR PLAINTIFF

CERTIFICATE OF SERVICE

The undersigned hereby certifies that all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document via the Court's CM/ECF system per Local Rule CV-5(a)(3). Any other counsel of record will be served by facsimile transmission and/or first class mail this 7th day of September, 2004.


